

**D. Remarks**

In response to the Office Action mailed May 17, 2004, the Applicants respectfully request reconsideration of the application in view of the following remarks.

Claims 1-36, 40, 41, 43-49, 52-90, 94, 95, 97-103, and 106-111 are currently pending.

***Rejection of claims 1-36, 40, 41, 43-49, 52-90, 94, 95, 97-103, and 106-111 under 35 USC 103(a)***

Claims 1-36, 40, 41, 43-49, 52-90, 94, 95, 97-103, and 106-111 stand rejected under 35 USC 103(a) as unpatentable over Decision Focus® Software, as disclosed in the following documents submitted by the Applicants:

“Decision Focus® Software User’s Guide (Version 1.0),” copyright 1995;

“Decision Focus® Software Network Version 1.0 User’s Guide,” copyright 1995;

Print-outs of On-Screen Worksheets from “Decision Focus® Software; and

Screenshots (FIGS. 1-24) from “Decision Focus® Software (Version 1.0)

*in view of* Lee (“Justifying Database Normalization: A Cost/Benefit Model”). The Decision Focus (DF) documents listed directly above are hereinafter referred to as the “DF documents.” Reconsideration and withdrawal of the obviousness rejection is deemed in order and requested.

**Description of the Invention**

Embodiments of the invention provide a computer software application, graphical user interface (GUI), and method for entering information concerning a complex business situation, refining such information in a stepwise manner through such an interface, generating a list of effective actions for addressing such a business situation, and storing such information in a knowledge base adapted for future query and reporting use for such complex business situations. A set or sequence of process screen structures allows entry of specific aspects of such a situation to generate such an action list. Such process screen sequences provide a systematic method to gather and organize information effectively in order to resolve a complex situation, and to store such information in a knowledge base for later query and retrieval for the same or similar situations, thereby preserving enterprisewide knowledge and expertise. An action tracker interface is also provided which provides task management and monitoring of the various actions determined by the process screen sequences. The user has the ability to access the process screens in a non—linear mode and can toggle between interview and worksheet modes.

### **Claim 1**

Amended claim 1 provides a method of gathering, processing, storing, and displaying information concerning a complex business situation. The method includes providing a graphical user interface for entering data concerning the complex business situation; refining the data in a predetermined, stepwise manner through user interaction with the graphical user interface; generating, through the stepwise manner and the graphical user interface, a list of effective actions for addressing the complex business situation; and *storing the data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval in performing the steps of refining and generating*. The knowledge base enables *selection of an in process analysis for modification by a user*. Claims 2 and 3 contain similar limitations.

### **Response to rejection of claims 1-3**

Contrary to the assertion in the May 17, 2004 Office Action that claim 1 is obvious over the DF documents in view of the Lee document, claim 1 recites elements/limitations that are completely absent from the DF documents and the Lee document, alone or in combination.

#### **The DF documents**

In particular, the DF documents do not disclose “*storing the data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval in performing the steps of refining and generating* [emphasis added],” as claimed in currently pending claim 1. The knowledge base is shown as element 42 in FIG. 2 of the present application. Embodiments of the structure of the knowledge base are illustrated in FIGS. 38-42 of the present application.

The May 17, 2004 Office Action addresses the obviousness rejection of claim 1 on page 21 and states in relevant part:

Claims 1-3 recite limitations already addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 above; therefore the same rejection applies.

Claims 1-3 contain elements/limitations, including the element(s)/limitation(s) underlined and italicized above, that are unique to claims 1-3. Thus, Applicants respectfully assert that claims 1-3 recite limitations that were not addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57. Moreover, portions of both a previously issued June 3, 2002 Office Action and a previously issued August 14, 2003 Office Action appear to acknowledge that the DF documents do not disclose the element(s)/limitation(s) underlined and italicized above.

More specifically, page 11 of the June 3, 2002 Office Action issued in this case states:

EDI [Decision Focus® Software User’s Guide (Version 1.0)] does not expressly teach storing said data in an indexed and normalized form in a

knowledge base adapted for structured query and retrieval in performing said steps of refining and generating.

Furthermore, page 11 of the August 14, 2003 Office Action in this case states:

Broadly speaking, a “knowledge base” merely refers to a collection of knowledge, i.e., data; therefore, the collection of these worksheet files serves as a “knowledge base.” Decision Focus® Software does not expressly teach that these centrally stored worksheet files are linked to one another in a large database (which is what would be suggested by placing the information found in such files in a “knowledge base”). [Emphasis added.]

Thus, the two portions of the June 3, 2002 Office Action and the August 14, 2003 Office Action quoted immediately above appear to acknowledge that the DF documents do not disclose the element(s)/limitation(s) italicized and underlined above.

In addition, the DF documents do not teach “*selection of an in process analysis for modification by a user,*” as claimed in currently pending claim 1.

As noted above, page 21 of the May 17, 2004 Office Action addressing the obviousness rejection of claim 1 states:

Claims 1-3 recite limitations already addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 above; therefore the same rejection applies.

Furthermore, regarding the limitation “*said knowledge base enabling selection of an in process analysis for modification by a user*” (as recited in claims 1-3), the networked version of Decision Focus® Software allows a user to access data currently being used by another person. The user then makes a copy of the desired file so that he/she does not overwrite someone else’s work, thereby implying that the user can modify the data in the copied file (“Decision Focus® Software Network Version 1.0 User’s Guide”: Page 11). [Emphasis added.]

In contrast to the above-quoted characterization of page 11 of DF Network (DECISION FOCUS Software, Network Version 1.0, User’s Guide) and with reference to that same page 11, if a user attempts to open a worksheet file that is already opened by someone else running Decision Focus, “the software informs the user that the file is already in use”. Although a user appears to be able to make a copy of the file, *as stated on page 11 of DF Network, “if you subsequently attempt to save that copy, you are not allowed to save the copy to the same name as the original file name. This is to protect you from overwriting someone else’s work”* Thus, the DF documents do not teach that the knowledge base enables selection of an **in process** analysis for modification by the user, as claimed in currently pending claim 1, *because a user of DF Network cannot modify an in process analysis.* The ability to modify an in process analysis

is advantageous, among other reasons, for collaborative analysis, i.e., an analysis by more than one individual.

In response to Applicants arguments above (made in Applicants December 12, 2003 response), page 3 of the May 17, 2004 Office Action states the following:

The claim language does not preclude a user from making a copy of an in process analysis and then making changes, which are to be saved under a different file name. As recited in claim 1, for example, a user of Decision Focus Software can select an in process analysis (i.e., Decision Focus Software user can make a copy of a “worksheet file that is already opened by someone else running Decision Focus,” page 11 of “Decision Focus Software Network Version 1.0 User’s Guide”). The user can then modify the copied file and save it under a different file name in order to prevent overwriting of someone else’s work (page 11 of “Decision Focus Software Network Version 1.0 User’s Guide”). *The claim language does not specify how a modification of an in process analysis is saved (e.g., saved under a different file name, overwrites the original process analysis, etc.).* [Emphasis added].

Applicants submit that the phrase “selection of an in process analysis for modification by a user” is commonly understood in the English language to mean the selection of an analysis-that-is-in-the-process-of-being-performed for modification by a user. MSN’s Encarta dictionary defines “in process” as follows: underway, in the process of happening. In light of this understanding of the highlighted claim language, the act of making a copy of an analysis and saving it to a different filename removes the analysis from being in process and freezes the analysis at a particular point in time, taking the analysis out of process. As noted above, the ability to modify an in process analysis is advantageous, among other reasons, for collaborative analysis, i.e., an analysis by more than one individual.

#### **The Lee document**

Furthermore, the Lee document does not disclose the element(s)/limitation(s) italicized and underlined above, i.e., 1) *storing the data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval in performing the steps of refining and generating;* and/or 2) *selection of an in process analysis for modification by a user,* as claimed in currently pending claim 1. As noted above, page 21 of the May 17, 2004 Office Action addresses the obviousness rejection of claim 1 stating in relevant part:

Claims 1-3 recite limitations already addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 above; therefore the same rejection applies.

Claims 1-3 contain elements/limitations, including the element(s)/limitation(s) underlined and italicized above, that are unique to claims 1-3. Thus, Applicants respectfully assert that

claims 1-3 recite limitations that were not addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57.

Furthermore, the Office Action appears to discuss the Lee document only briefly on pages 14 and 15. On page 14, the May 17, 2004 Office Action states in relevant part:

Lee discusses the benefits (“reduced anomalies, storage requirements, and transaction response time”) of utilizing normalized databases “in information systems development processes to group data into well-refined structures.”

The May 17, 2004 Office Action appears to be quoting a portion of the abstract of the Lee document. The complete abstract indicates that there are costs associated with normalization. More specifically, the complete abstract states the following:

Proposes a **cost/benefit model** coupled with a decision tree for determining normal forms, which are used in information systems development processes to group data into well-refined structures. The three primary variables that impact the benefits **and costs of normalization** (reduced anomalies, storage requirements, and transaction response times) **are addressed**. [Emphasis added.]

In any event, the Lee abstract in particular and the Lee document in general do not teach:  
1) storing the data in an indexed and normalized form in a knowledge base adapted for structured query and retrieval in performing the steps of refining and generating; and/or 2) selection of an in process analysis for modification by a user, as claimed in currently pending claim 1.

#### **The DF and Lee documents**

The May 17, 2004 Office Action does not and can not point to a teaching in the DF and/or Lee documents of the above-referenced element(s)/limitation(s). If the Examiner repeats this rejection, the Applicant respectfully requests that the Examiner specify where in either the DF documents or the Lee document such element(s)/limitation(s) is/are taught.

Given that the DF documents and/or the Lee document do not teach the above-referenced recitation(s), even if one were to combine Lee and the DF documents as suggested one would not arrive at the claimed invention.

Furthermore, there is no motivation or suggestion in the cited documents to make the combination indicated in the Office Action. Obviousness cannot be established by combining the teachings of the cited documents to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination. See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).

It is impermissible for an Examiner to use the claimed invention as a “template” to piece together the teachings of the prior art references so as to render the claimed invention obvious. In re Gorman, 933 F.2d 982, 987 (Fed. Cir. 1991). Under no condition can an Examiner combine the teachings of references, unless those references include some teaching or suggestion supporting the combination. In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (quoting ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 (Fed. Cir. 1984))

An Examiner is not allowed to use hindsight to pick and choose among pieces of prior art references so as to reconstruct the claimed invention. In re Fritch, 972 F.2d at 1266. As the Federal Circuit has observed on more than one occasion, “[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (quoting W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983)). See also Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 313, 227 USPQ 2d. 1923, (Fed. Cir. 1985) Additionally, it is improper to focus on obviousness of substitutions, instead of on an invention as a whole. Gillette Co. v. S.C. Johnson & Son, Inc. 16 USPQ 2d. 1923 (Fed. Cir. 1990)

It is the invention as a whole which must be evaluated. “...the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee’s method and device.” Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ 2d. 1321 (Fed. Cir. 1990)

As noted above, the May 17, 2004 Office Action addresses the obviousness rejection of claim 1 on page 21 and states in relevant part:

Claims 1-3 recite limitations already addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 above; therefore the same rejection applies.

Claims 1-3 contain elements/limitations, including the element(s)/limitation(s) underlined and italicized above, that are unique to claims 1-3. Thus, Applicants respectfully assert that claims 1-3 recite limitations that were not addressed by the rejection of claims 4-36, 40, 41, 43-49, and 52-57 and, moreover, that the May 17, 2004 Office Action does not point to where in the cited documents one can find a motivation or suggestion to combine the cited documents to achieve the invention claimed in currently pending claim 1.

Pages 3-4 of the May 17, 2004 Office Action states the following in response to this assertion by the Applicant:

Applicant fails to address Examiner's combination of Decision Focus Software and Lee as a whole. For example, Applicant does not address Examiner's preface to the teachings of Lee:

Regarding claims 4, 35, and 36, Decision Focus Software comes in a networked version in which worksheet files can be saved on a network server and shared among various users ("Decision Focus Software Network Version 1.0 User's Guide": Pages 5, 10, 11). Broadly speaking, a "knowledge base" merely refers to a collection of knowledge, i.e., data; therefore, the collection of these worksheet files serves as a "knowledge base." Decision Focus Software does not expressly teach that these centrally stored worksheet files are linked to one another in a large database (which is what would be suggested by placing the information found in such files in a "knowledge base"); however, as discussed above, various users can access the worksheet files of other people for their personal use. [Emphasis added.] [Quoted from the August 14, 2003 Office Action issued in this case.]

Clearly, the teaching of Decision Focus Software in conjunction with those of Lee yield not only the necessary motivation to combine the teachings of both references, but also the claimed invention as a whole. For example, as explained in the art rejection, Decision Focus Software comes in a networked version that allows users to share worksheet files with one another. This furthers the sharing of knowledge among users. Lee merely fills in the blanks regarding the use of normalized databases as opposed to non-normalized ones, which Examiner asserts is a very old and well-known concept in the art of database management. [Emphasis added.]

The Office Action also discusses the Lee document on pages 14 and 15. On page 14, the May 17, 2004 Office Action states in relevant part::

Lee discusses the benefits ("reduced anomalies, storage requirements, and transaction response time") of utilizing normalized databases "in information systems development processes to group data into well-refined structures." Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to centrally store the data from Decision Focus® Software collective worksheet files in a "knowledge base" (in the stricter sense of a "knowledge base" as a database per se of information), such as a normalized database, in order to facilitate access to all of the collected worksheet files by various networked users through keyword searches in order to provide quick access to data in a manner that reduces anomalies, minimizes storage requirements, and improves transaction response time (as taught by Lee). [Emphasis added.]

As noted above, obviousness cannot be established by combining the teachings of the cited documents to produce the claimed invention, absent some teaching suggestion or incentive

supporting the combination. It is impermissible for the Examiner to use the claimed invention as a “template” to piece together the teachings of the prior art references so as to render the claimed invention obvious. Under no condition can an Examiner combine the teachings of references, unless those references include some teaching or suggestion supporting the combination. Additionally, it is improper to focus on obviousness of substitutions, instead of on an invention as a whole. It is the invention as a whole which must be evaluated. “...the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee’s method and device.”

In contrast to the characterization of the teaching of Lee provided in the quotes above from the May 17, 2004 Office Action, Lee teaches away from making the suggested combination. The Lee document describes design choices that one makes when designing a relational database and describes the efforts that one undertakes to create and maintain a relational database model. For example, the second full paragraph of page 2 of the Lee document states in relevant part:

[the database administrator] is often responsible for backing up and restoring the database when it becomes corrupted due to equipment failure, power loss, or program errors.

The top of page 3 of the Lee document continues to describe needs associated with a relational model/database:

Real-world data are rarely organized according to the relational model, and careful consideration needs to be given to alternatives in balancing theoretical aspects of the relational model with real-world processing requirements and performance of the resulting computerized application.

The fourth full paragraph on page 12 notes that a data manager must be able to safeguard sensitive data from access by unauthorized personnel. The last paragraph on page 13 again continues to describe needs associated with a relational model/database:

The concept of transaction processing should be applied to preserve database integrity and consistency, and techniques such as key fields, indexing, and query methods must be considered in addressing the important issue of system performance.

Indeed, as noted above, the complete abstract of Lee indicates that there are costs associated with normalization. More specifically, the complete abstract states the following:



Proposes a **cost/benefit model** coupled with a decision tree for determining normal forms, which are used in information systems development processes to group data into well-refined structures. The three primary variables that impact the benefits **and costs of normalization** (reduced anomalies, storage requirements, and transaction response times) **are addressed**. [Emphasis added.]

Thus, reading the Lee document, one would not be motivated to add a central relational database to the subject matter of the DF documents to achieve the claimed invention because of the effort required (as described in the Lee document) to develop and maintain a relational database. In other words, the Lee document teaches that relational database development and maintenance are complicated processes requiring effort and thought. Thus, the Lee document teaches away from adding a central relational database to a networked decision making system because one would need a compelling reason to create and maintain a central relational database and because the Lee document does not appear to even discuss adding a central database to a pre-existing networked system.

In response to Applicants arguments above (made in Applicants December 12, 2003 response) page 5 of the May 17, 2004 Office Action states the following:

First, as explained above and in the art rejection, the networked version of Decision Focus Software allows users to share worksheet files with one another. Broadly speaking, a “knowledge base” merely refers to a collection of knowledge, i.e., data; therefore, the collection of these worksheet files serves as a “knowledge base.” Lee states that normalization yields the benefits of “reduced anomalies, storage requirements, and transaction response times” (abstract). Applicant’s assertion that implementing a normalized database is very complex and, therefore, one of ordinary skill in the art at the time of Applicant’s invention would not have been motivated to incorporate one into the Decision Focus Software ignores the important benefits of choosing to implement such a database. *Whether or not making this modification (e.g. adding a normalized database) to Decision Focus Software would pose a daunting task, one of ordinary skill in the art at the time of Applicant’s invention would not overlook these benefits of “reduced anomalies, storage requirements, and transaction response times” (abstract).* For example, users in a network are often concerned with potential anomalies in data storage and retrieval, lack of storage/overwhelming storage requirements, and data storage and retrieval response times. The users of the networked version of Decision Focus Software are likely no different and, therefore, the Examiner maintains that one of ordinary skill in the art would indeed have been motivated and found it obvious to incorporate a normalized database with Decision Focus Software for the reasons presented in Lee in light of the goals of the networked version of Decision Focus Software, as discussed in the art rejection. [Emphasis added.]

In contrast to the italicized and underlined portion of the quote directly above, Applicants respectfully submit that if a reference teaches that making a combination/modification proposed by an Examiner would pose a daunting task, then that reference is not providing a motivation or suggestion to make the combination/modification. As noted above, obviousness cannot be established by combining the teachings of the cited documents to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination. . See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). Applicants submit that, for the reasons cited above, the Lee document does indeed indicate that relational database development and maintenance are complicated processes requiring effort and thought and, therefore, that modifying the teachings of the DF documents to achieve the subject matter of claim 1 would be a daunting task.

The August 14, 2003 Office Action does not and can not point to a disclosure in the Lee document that provides a suggestion or motivation to make the combination suggested in the Office Action to achieve the invention claimed in claim 1. If the Examiner repeats this rejection, the Applicant respectfully requests that the Examiner specify where in either the DF documents and/or the Lee document such a teaching or motivation is provided.

In sum, for the reasons cited above, currently pending claim 1 is patentably distinct from the DF documents and the Lee document, alone or in combination.

Claims 2 and 3 include similar limitations to claim 1. Therefore, for the reasons cited above, claims 1-3 are patentably distinct over the DF documents and the Lee document, alone or in combination and the rejection of claims 1-3 under 35 USC 103 as obvious over the DF documents in view of the Lee document is traversed.

#### **Independent Claims 4 and 58**

Claim 4 provides a process for eliciting, processing, storing, and displaying information concerning a complex business situation. The process includes: employing a knowledge base providing for structured storage and retrieval of data; employing at least one of: a) a situation appraisal process; b) a problem analysis process; c) a decision analysis process; and d) a potential side effect analysis process; and employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status; wherein each process employs a corresponding set of graphical user interface (GUI) process screens in eliciting data from and presenting data to a user.

The situation appraisal process elicits, stores, retrieves and presents situation data, the situation data including (i) concerns about the situation and respective attributes of the concerns, the attributes of each concern including a relative priority and a process to be used for further analysis, and (ii) actions to be taken to address the concerns. The problem analysis process elicits, stores, retrieves and presents problem data including an object of a problem in the situation and attributes of the object, the attributes including a deviation, possible causes, actions to be taken to confirm a true cause, a confirmed true cause, and actions to be taken to address the confirmed true cause. The decision analysis process elicits, stores, retrieves and presents decision data, the decision data including (i) objectives of a decision regarding the situation and respective attributes of the objectives, the attributes of each objective including an indication of relative importance and at least one alternative, (ii) for each alternative a set of risks and respective probabilities and consequences, (iii) a final decision regarding alternatives to be pursued, and (iv) actions to be taken to implement the final decision. The potential side effect analysis process elicits, stores, and presents potential side effect data, the side effect data including potential side effects of an action to be taken to address the situation and respective attributes of the potential side effects, the attributes of each potential side effect including a likely cause, actions to be taken to influence the likelihood of occurrence of the side effect, and actions to be taken in the event of occurrence of the side effect.

Independent claim 58 contains elements/limitations similar to those of claim 4.

#### **Response to rejection of claims 4-111**

Contrary to the assertion in the May 17, 2004 Office Action that claim 4 is obvious over the DF documents in view of the Lee document, claim 4 recites element(s)/limitation(s) that are completely absent from the DF documents and the Lee document, alone or in combination.

#### **The DF documents**

In particular, as acknowledged by the May 17, 2004 Office Action, the DF documents do not teach “employing a knowledge base providing for structured storage and retrieval of data,” as claimed in currently pending claim 4. More specifically, pages 14-15 of the May 17, 2004 Office Action state in relevant part:

Regarding claims 4, 35, and 36, Decision Focus® Software comes in a networked version in which worksheet files can be saved on a network server and shared among various users (“Decision Focus® Software Network Version 1.0 User’s Guide”: Pages 5, 10, 11). Broadly speaking, a “knowledge base” merely refers to a collection of knowledge, i.e., data; therefore the collection of these worksheet files serves as a “knowledge base.” Decision Focus® Software does

not expressly teach that these centrally stored worksheet files are linked to one another in a large database (which is what would be suggested by placing the information found in such files in a “knowledge base”). [Emphasis added.]

In addition, the DF documents do not disclose “employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status” [emphasis added],” as claimed in currently pending claim 4. The action tracker is shown as element 20 in FIG. 1 and is described, among other places, on pages 35 and 36 of the present application.

The May 17, 2004 Office Action discusses claim 4 on pages 8 and 9 and on pages 14 and 15. More specifically, the second paragraph of page 9 of the May 17, 2004 Office Action merely quotes the “action tracker” element(s)/limitation(s) underlined and italicized directly above and then states the following: “(‘Decision Focus® Software User’s Guide (Version 1.0)’: Pages 33-35).”

Pages 33-35 of Decision Focus® Software User’s Guide (Version 1.0) (hereinafter DF User’s Guide) describes ‘Problem Prevention.’ According to page 33 of the DF User’s Guide, Problem Prevention is the systematic analysis of a plan to provide assurance that a minimum of problems will occur during implementation. Pages 33-35 of DF User’s Guide continue to describe steps for creating a problem prevention worksheet, entering a planning statement, listing the steps necessary for implementing the plan, identifying potential problems and entering preventive and contingent actions.

Pages 33-35 of the DF User’s Guide do not disclose “employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status,” as claimed in currently pending claim 4. The element(s)/limitation(s) italicized directly above are completely absent from the DF User’s Guide. Retrieving actions from the other processes advantageously allows a user to take advantage of work that has been done in the past and/or in other contexts.

In response to Applicants argument above (made in Applicants December 12, 2003 response), page 6 of the May 17, 2004 Office Action merely states the following:

On pages 26-31 of Applicant’s response, Applicant presents similar arguments for claims 4 and 58 as those presented for claims 1-3 above. The same responses from Examiner apply.

Applicants respectfully submit that Applicants arguments for claims 4 and 58 involve a recitation(s), e.g., “employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status,” and associated arguments that are completely unique to claims 4 and 58. Thus, Applicants submit that the same responses from the Examiner do not apply.

#### **The Lee document**

Furthermore, the Lee document does not disclose the element(s)/limitation(s) italicized and underlined above, i.e., 1) employing a knowledge base providing for structured storage and retrieval of data, and/or 2) employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the actions, the attributes of each action including a responsible person, a deadline, and status [hereinafter “the action tracker recitation”], as claimed in currently pending claim 4. As noted above, the May 17, 2004 Office Action discusses claim 4 on pages 8 and 9 and on pages 14 and 15.

The August 14, 2003 Office Action discusses the Lee document on pages 14 and 15. On pages 14 and 15, the August 14, 2003 Office Action states in relevant part:

Lee discusses the benefits (“reduced anomalies, storage requirements, and transaction response time”) of utilizing normalized databases “in information systems development processes to group data into well-refined structures.”

The May 17, 2004 Office Action appears to be quoting a portion of the abstract of the Lee document. The complete abstract indicates that there are costs associated with normalization. More specifically, the complete abstract states the following:

Proposes a **cost/benefit model** coupled with a decision tree for determining normal forms, which are used in information systems development processes to group data into well-refined structures. The three primary variables that impact the benefits **and costs of normalization** (reduced anomalies, storage requirements, and transaction response times) **are addressed**. [Emphasis added.]

Furthermore, the May 17, 2004 Office Action does not and cannot point to a teaching in Lee of the action tracker recitation. Thus, the Lee abstract in particular and the Lee document in general do not teach: 1) employing a knowledge base providing for structured storage and retrieval of data, and/or 2) employing an action tracker process to (i) retrieve and present actions from the other processes, and (ii) to elicit, store, retrieve and present attributes of the

actions, the attributes of each action including a responsible person, a deadline, and status, as claimed in currently pending claim 4.

#### **The DF and Lee documents**

The May 17, 2004 Office Action does not and can not point to a teaching in the DF and/or Lee documents of the above-referenced element(s)/limitation(s). If the Examiner repeats this rejection, the Applicant respectfully requests that the Examiner specify where in either the DF documents or the Lee document such element(s)/limitation(s) is/are taught.

Given that the DF documents and/or the Lee document do not teach the above-referenced recitations, even if one were to combine Lee and the DF documents as suggested one would not arrive at the claimed invention.

Furthermore, there is no motivation or suggestion in the cited documents to make the combination indicated in the Office Action. As noted above, obviousness cannot be established by combining the teachings of the cited documents to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

As noted above, the only statements made in the May 17, 2004 Office Action directly addressing the obviousness rejection of claim 4 are located on pages 8 and 9 and on pages 14 and 15.

In addition, the Office Action discusses the Lee document briefly on pages 14 and 15 stating in relevant part:

Lee discusses the benefits (“reduced anomalies, storage requirements, and transaction response time”) of utilizing normalized databases “in information systems development processes to group data into well-refined structures.” Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to centrally store the data from Decision Focus® Software collective worksheet files in a “knowledge base” (in the stricter sense of a “knowledge base” as a database per se of information), such as a normalized database, in order to facilitate access to all of the collected worksheet files by various networked users through keyword searches in order to provide quick access to data in a manner that reduces anomalies, minimizes storage requirements, and improves transaction response time (as taught by Lee). [Emphasis added.]

In contrast to the characterization of the teaching of Lee provided in this quote from the May 17, 2004 Office Action, Lee teaches away from making the suggested combination. As noted above, the Lee document describes design choices that one makes when designing a relational database and describes the efforts that one undertakes to create and maintain a

relational database model. For example, the second full paragraph of page 2 of the Lee document states in relevant part:

[the database administrator] is often responsible for backing up and restoring the database when it becomes corrupted due to equipment failure, power loss, or program errors.

The top of page 3 of the Lee document continues to describe needs associated with a relational model/database:

Real-world data are rarely organized according to the relational model, and careful consideration needs to be given to alternatives in balancing theoretical aspects of the relational model with real-world processing requirements and performance of the resulting computerized application.

The fourth full paragraph on page 12 notes that a data manager must be able to safeguard sensitive data from access by unauthorized personnel. The last paragraph on page 13 again continues to describe needs associated with a relational model/database:

The concept of transaction processing should be applied to preserve database integrity and consistency, and techniques such as key fields, indexing, and query methods must be considered in addressing the important issue of system performance.

Thus, reading the Lee document, one would not be motivated to add a relational database to the subject matter of the DF documents to achieve the claimed invention because of the effort required (as described in the Lee document) to develop and maintain a central relational database. In other words, the Lee document teaches that relational database development and maintenance are complicated processes requiring effort and thought. Thus, the Lee document teaches away from adding a central relational database to a pre-existing networked decision making system because one would need a compelling reason to create and maintain a central relational database and because the Lee document does not appear to even discuss adding a central database to a pre-existing networked system.

The May 17, 2004 Office Action appears to indicate that the suggestion or motivation to combine the Lee and DF documents to achieve the claimed combination is provided by the Lee Abstract. More specifically, page 14 of the May 17, 2004 Office Action appears to indicate that the suggestion or motivation to combine the Lee and DF documents to achieve the claimed combination is 'to provide quick access to data in a manner that reduces anomalies, minimizes storage requirements, and improves transaction response time (as taught by Lee).' However, the Lee abstract, when read in full, describes variables that impact the benefits and costs of

**normalization** (versus non-normalization). In other words, the cited section of the Lee abstract is not describing the benefits of adding a central database to a pre-existing networked system but rather the benefits and costs of normalizing a database.

The May 17, 2004 Office Action does not and can not point to a disclosure in the Lee document that provides a suggestion or motivation to make the combination suggested in the Office Action to achieve the invention claimed in claim 1. If the Examiner repeats this rejection, the Applicant respectfully requests that the Examiner specify where in either the DF documents and/or the Lee document such a teaching or motivation is provided.

In sum, for the reasons cited above, currently pending claim 4 is patentably distinct from the DF documents and the Lee document, alone or in combination.

Independent claim 58 is a computer readable medium claim that includes elements/limitations similar to claim 4. Therefore, for the reasons cited above, claim 58 is patentably distinct over the DF documents and the Lee document, alone or in combination. Furthermore, claims 5-57 and 59-111 are dependent on claims 4 and 58, respectively. Therefore, claims 5-57 and claims 59-111 are patentably distinct over the DF documents and the Lee document, alone or in combination, at least for the reasons cited above with respect to claim 4 and the rejection of claims 4-111 under 35 USC 103 as obvious over the DF documents in view of the Lee document is traversed.

Furthermore, the subject matter of the dependent claims, e.g., claims 30 and 46-57, further patentably distinguish over the cited documents. For example, claim 30 recites the following: "A process according to claim 4, wherein the action tracking process further includes eliciting, storing, retrieving, and presenting process data from at least one of the other processes in addition to the associated actions." In rejecting claim 30, page 9 of the August 14, 2003 Office Action merely cites pages 11-32 of the DF User's Guide without further explanation. Applicant's respectfully request, if this rejection is repeated, that the Examiner specify where in the DF User's Guide the subject matter of claim 30 is taught.

In response to Applicants arguments above (made in Applicants December 12, 2003 Response), page 6 of the May 17, 2004 Office Action states the following:

Applicant requests more explanation regarding the rejection of claim 30 (pages 31-32 of Applicant's response). As stated in the art rejection, the limitation "wherein the action tracking process further includes eliciting, storing, retrieving, and presenting process data from at least one of the other processes in addition to the associated actions" (claim 30) is addressed on pages 11-32 of "Decision Focus® Software User's Guide (Version 1.0)." Each of the four recited analyses in steps (a)-(d) can be elicited, stored, retrieved, and presented (see discussion of



the specific steps (a)-(d) in the art rejection, which has not been argued by Applicant). Therefore, a user has access to any and all of the four recited analyses and related worksheets. [Emphasis added.]

The only additional explanation provided as to the rejection of claim 30 in light of 21 pages of the Decision Focus® Software User's Guide (Version 1.0) is the underlined portion of the quote above. This quote does not point to a specific section of the User's Guide or even assert that the User's Guide teaches the relevant recitation, i.e., wherein the action tracking process further includes eliciting, storing, retrieving, and presenting process data from at least one of the other processes in addition to the associated actions. Indeed, the DF documents do not teach the claimed action tracking process. Thus, Applicants respectfully submit that the 35 USC 103 rejection of claim 30 is traversed.

Moreover, with respect to a number of claims, e.g., claims 8-16 (pages 13-15 of the August 14, 2003 Office Action) and 43-45 (page 16 of the August 14, 2003 Office Action), the Examiner takes Official Notice that a variety of subject matter is old and well known in a variety of arts. For example, page 14 of the August 14, 2003 Office Action states the following:

Official Notice is taken that the process of checking to screen and filter data input by a user with the motivation of ensuring the completeness and correctness of the entered data (claim 9) is old and well known in the art of form filing. Official Notice is also taken that, for the same reasons (i.e., to ensure the completeness and corrections [sic] of entered data), it is old and well-known in the art of form filing to perform the following types of proofreading/completion checking/error correction: check misstated information to detect skipped steps, unsound data, and incomplete analysis (claim 10); check common pitfalls to advise the user of pitfalls that can be encountered as a result of impreciseness in the entered data (claim 11); sharpen to successively refine entered data considered to be critical to proper analysis (claim 12); notify the user upon detection of incomplete or incorrect data (claim 13); notify the user by displaying a message to the user as the user attempts to advance to a succeeding GUI process screen (claim 14); and notify the user by displaying a message to the user immediately upon detection of incomplete or incorrect data (claim 15). [Emphasis added.]

The Applicants assert that the subject matter of claims 8-16 and 43-45 is not old and well known in the relevant art(s). In Applicants' December 12, 2003 Response, the Applicant stated the following with regard to these claims:

In the event that the Examiner repeats the 35 USC 103 rejection of claims 8-16 and 43-45 included in the August 14, 2003 Office Action, per MPEP 2144.03, Applicants respectfully request that the Examiner provide evidence, e.g., documentary evidence or an affidavit (if the Examiner is relying on personal

knowledge), to support the various takings of Official Notice on pages 13-16.  
[Emphasis added.]

In response to that request, page 6 of the May 17, 2004 Office Action states the following:

Applicant broadly challenges the Official Notice statements made in relation to claims 9-15, "The Applicants assert that the subject matter of claims 8-16 and 43-45 is not old and well-known in the relevant art(s)." (Page 32 of Applicant's response) It is not clear whether Applicant is challenging the validity of the Official Notice statements themselves or the motivation to combine them with the Decision Focus Software and Lee references. Furthermore, Applicant's blanket challenge amounts to nothing more than an unsupported challenge and is therefore insufficient to switch the burden back to the Examiner to cite supporting references (MPEP 2144.03) and/or present further arguments in support of the motivation to combine teachings. [Emphasis added.]

Applicants respectfully submit that Applicants' statement underlined above (i.e., per MPEP 2144.03, Applicants respectfully request that the Examiner provide evidence, e.g., documentary evidence or an affidavit (if the Examiner is relying on personal knowledge), to support the various takings of Official Notice on pages 13-16) is clear on its face. Indeed, MPEP 2144.03 states in relevant part:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute...If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

Specifically, and for example, Applicants assert that 1) checking misstated information to detect skipped steps, unsound data, and incomplete analysis (claim 10); 2) checking common pitfalls to advise the user of pitfalls that can be encountered as a result of impreciseness in the entered data (claim 11); and 3) successively refining entered data considered to be critical to proper analysis (claim 12) involve subject matter that is not old and well known in the art at the time of filing as evidenced by the fact that competitive products (documents describing competitive products have been submitted in information disclosure statements) did not

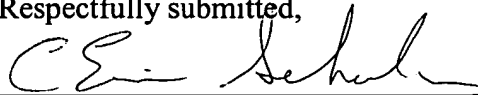
incorporate such subject matter. Thus, Applicants repeat their request that, per MPEP 2144.03, in the event that the Examiner repeats the 35 USC 103 rejection of claims 8-16 and 43-45 included in the May 17, 2004 Office Action, that the Examiner provide evidence, e.g., documentary evidence or an affidavit (if the Examiner is relying on personal knowledge), to support the various takings of Official Notice.

The Applicant believes that this application is in condition for allowance and respectfully request entry of this amendment and allowance of the application.

If there are any questions regarding these remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

The Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 24200-002 CON.

Respectfully submitted,



C. Eric Schulman, Esq. (Reg. No. 43,350)

Mintz, Levin, Cohn, Ferris

Glovsky and Popeo, P.C.

One Financial Center

Boston, MA 02111

Telephone 617/348-3005

Attorneys for Applicants

Date: July 9, 2004

**Customer Service No. 30623**